

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-8 were in the application, claims 3, 4 and 6 have been cancelled, and claims 1, 2, 5 and 7-8 have been amended.

Claim 1 has been amended to substantially incorporate the limitations of claims 3, 4 and 6 therein, and to improve clarity relative to the operation of the safety closure, which prevents translational movement in either direction when engaged in the second position. (P. 8, l.19-24) Claims 2, 5 and 7-8 were amended as to form, to correct claim dependencies and also for clarity.

Suitable headings have been added to the specification, per the Examiners' request.

The rejection for anticipation of claims 1-5 and 8 over Novak et al is rendered moot by the amendment of claim 1 to incorporate the limitations of claim 6 therein.

Claims 6 and 7 were rejected as being obvious over Novak et al.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Sys. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

While the examiner has speculated that it would be within the skill of one in the art to add a safety closure to the device of Novak, it is improper to propose such a modification without a teaching or suggestion to do so.

It is irrelevant in determining obviousness that all other aspects of the claimed invention are well known in a piecemeal manner, in the art, since virtually every patent can be described as a "combination patent", or a "combination of old elements". The mere fact that the disclosure of teachings of the prior art can be retrospectively combined for purposes of evaluating the obviousness/non-obviousness issue does not make the combination obvious unless the art also suggested the desirability of the combination or the inventor's beneficial results of the advantage to be derived from the combined teaching. Fromson v. Advanced Offset Plate, Inc. 755 F. 2d 1549, 1556 (Fed. Cir. 1985). At best it might be obvious to try various combinations, but obvious to try is not the standard and absent a teaching or suggestion for doing as the applicants have done.

In Novak, movement to the open position is limited by "engagement of pins 102 with the rearward ends of guide slots 104 as shown in Figs. 12 and 13" (col. 5, l. 63-65) While these pins prevent the magazine from being manually detached from the fastener tool 20, there are no means provided to retain the magazine in this position. Consequently, the magazine may accidentally slide forward during cleaning of a jam from the firing channel.

On the other hand the present invention provides a safety closure 49 that has means for stopping the stroke of the magazine, to retain the magazine during cleaning of a jam from the firing channel.

There is nothing in Novak which would lead one skilled in the art to see a need for the safety closure of the applicants' invention.


Another distinction from Novak is that the applicant has "a first active end position, in which said complementary head (9) is adjacent to said head (8), allowing the expulsion of said elements through said firing channel (7), to a second position, in which said complementary head (9) is substantially spaced from said head (8) in order to allow access to said firing channel (7)...", the complimentary head being mounted on a forward end of the box-like structure, so that the two move in unison.

In Novak, the magazine assembly 34 is separate from a nose assembly 36. A track member 72 is slidably supported for movement between an open position and a closed position. A track member 74 is separately supported for sliding movement, this member being part of a sliding assembly 112. Note in Figs. 10 and 11, when the magazine is pulled back, that the track member 72 has not moved and the nose portions remain in place such that clearing a jam cannot occur. Rather, one must engage in a second operation, pulling back to move the sliding track member 72 to disengage the nose portion. Consequently, the nose portion is not part of the magazine, and Novak requires many more components, as well as additional operations before a jam can be cleared. On the other hand, the applicants' invention is simpler in construction, as well as safer, and provides much quicker and easier clearing of jams. Clearly, there is no teaching or suggestion for the simplified magazine with the complimentary end head in accordance with the applicants' invention, and claims 1, 2, 5 and 7-8 are patentable over the cited patent.

Based on the above amendments and remarks, favorable consideration and allowance of the application is respectfully requested. However should the examiner

believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

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